

### REMARKS

This responds to the Office Action mailed on January 4, 2007.

Claims 10 and 20 are amended. Claims 30-32 are canceled. No claims are added. As a result, claims 10-21, 23-26, and 29 are now pending in this application. Applicant respectfully submits that the amendments to the claims are fully supported by the specification, as originally filed, and no new matter has been added. Applicant hereby respectfully requests further examination and reconsideration of the application in view of the following remarks.

#### *Finality of the Rejection*

Applicant respectfully traverses the finality of the January 4, 2007 Office Action. Applicant respectfully submits that the first action final rejection is inappropriate because not all of the claims of the “new” application (i.e., the application after filing of the RCE of November 3, 2006) are drawn to the same invention claimed in the “earlier” application (i.e., the application prior to filing of the RCE of November 3, 2006), and not all of the claims would have been properly finally rejected on the grounds and art of record in the next Office Action if they had been entered in the “earlier” application. *See* MPEP § 706.07(b). Specifically, Applicant previously amended claim 20 to recite “attaching a multi-axis local adjustment device to the adjustable joint”. Applicant submits that the grounds *of record* of rejection of claim 20 are insufficient to reject claim 20, as amended. As evidence of this, in the Response to Arguments section of the Office Action at pages 2-3, the Office Action states *new grounds* of rejection contending that Franck et al. shows a multi-axial device. Applicant disagrees with this statement but has been left without an opportunity to traverse due to the finality of the present Office Action. Moreover, the RCE of November 3, 2006 was filed on the six-month date merely to avoid abandonment of the application. Had Applicant received an Advisory Action stating the new grounds of rejection pertaining to the alleged multi-axial device of Franck et al., Applicant could have submitted a response with the RCE traversing these new grounds of rejection. Applicant respectfully submits that by now asserting these new grounds of rejection in a first action Final Office Action, Applicant has been left without a full and fair opportunity to respond

to this basis of rejection. Accordingly, Applicant respectfully requests withdrawal of the finality of the present Office Action, and respectfully reserves the right to further petition the same.

§103 Rejection of the Claims

Claims 10-17, 20, 21, and 29-32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Franck et al. (U.S. Patent No. 6,529,765 B1) in view of Truwit (U.S. Patent No. 6,206,890 B1). Applicant respectfully traverses the rejection for at least the following reasons.

Applicant initially notes that claims 30-32 have been canceled, thereby rendering the rejection of claims 30-32 moot.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *M.P.E.P. § 2143.03*. Even assuming, for the sake of argument, that Franck et al. and Truwit are combinable in the way suggested by the Office Action, Applicant cannot find all recitations of claims 10-17, 20, 21, and 29. For instance, Applicant cannot find in either Franck et al. or Truwit:

- an MR compatible local adjustment device including: a slide body movably coupled to the base; a block slidably attached to the slide body; a collar engaged to the insertion guide and movably retained by the block, the collar and block forming a ball and socket joint between the block and the insertion guide; and a threaded adjuster coupled to the block, the threaded adjuster configured to cause linear motion of the collar with respect to the slide, as recited in amended claim 10; and
- attaching a multi-axis local adjustment device to the adjustable joint, the local adjustment device including a slide body rotatably coupled to the base, a block slidably attached to the slide body, and a collar engaged to the insertion guide and movably retained by the block, the collar and block forming a ball and socket joint between the block and the insertion guide; and remotely actuating the actuator to adjust alignment of the insertion axis within the range of motion, the actuator configured to cause at least one of motion of the slide body with respect to the base and linear motion of the block with respect to the slide body, the motion of the slide body with respect to the base being one of linear motion and rotatable motion.

Specifically, Applicant cannot find in either Franck et al. or Truwit any discussion of, for instance, an insertion guide coupled to the base using an adjustable joint and a local adjustment device also coupled to the insertion guide via a ball and socket joint separate from the adjustable joint, as shown in at least Figs. 3A, 3B, 4, and 5 of the present application. Instead, Franck et al. appears to discuss only a “[s]pherical portion 914 [that] mates with a spherical socket 916 in the bottom of rotating collar 830.” (Franck et al., col. 12, lines 52-54.) Similarly, Truwit appears to discuss a device having only a single ball or movable member, as shown in, for instance, Figs. 2-4, 9, 31, 39, 40, 42, 44, 45, and 53-55 of Truwit. For at least these reasons, Applicant submits that claims 10 and 20 are patentable over the proposed Franck et al. and Truwit combination.

Dependent claims 11-17, 21, and 29 depend from independent claims 10 and 20 either directly or indirectly, and accordingly incorporate the features of these independent claims. These dependent claims are accordingly believed to be patentable for the reasons stated herein. For brevity, Applicant defers (but reserves the right to present) further remarks, such as concerning any dependent claims, which are believed separately patentable.

For at least these reasons, Applicant believes claims 10-17, 20, 21, and 29 to be patentable over Franck et al. and Truwit. Accordingly, Applicant respectfully submits that the § 103(a) rejection of claims 10-17, 20, 21, and 29 is improper and requests withdrawal of this rejection.

Claims 18, 19, and 23-26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Franck et al. in view of Truwit as applied to claims 10 and 20 above, and further in view of Lee et al. (U.S. Patent No. 3,893,449). Applicant respectfully traverses this rejection.

Claims 18, 19, and 23-26 depend from independent claims 10 and 20, either directly or indirectly, and accordingly incorporate the features of these independent claims. As stated above, Applicant believes that claims 10 and 20 are allowable. Therefore, Applicant submits that claims 18, 19, and 23-26 are allowable based upon at least their respective dependence from claims 10 and 20.

For at least these reasons, dependent claims 18, 19, and 23-26 are believed to be patentable. Accordingly, Applicant respectfully submits that no *prima facie* case of obviousness exists with respect to such claims. For brevity, Applicant defers (but reserves the right to

present) further remarks, such as concerning any dependent claims, which are believed separately patentable. Thus, Applicant respectfully requests withdrawal of these bases of rejection for claims 18, 19, and 23-26.

*Reservation of Rights*

In the interest of clarity and brevity, Applicant may not have addressed every assertion made in the Office Action. Applicant's silence regarding any such assertion does not constitute any admission or acquiescence. Applicant reserves all rights not exercised in connection with this response, such as the right to challenge or rebut any tacit or explicit characterization of any reference or of any of the present claims, the right to challenge or rebut any asserted factual or legal basis of any of the rejections, the right to swear behind any cited reference such as provided under 37 C.F.R. § 1.131 or otherwise, or the right to assert co-ownership of any cited reference. Applicant does not admit that any of the cited references or any other references of record are relevant to the present claims, or that they constitute prior art. To the extent that any rejection or assertion is based upon the Examiner's personal knowledge, rather than any objective evidence of record as manifested by a cited prior art reference, Applicant timely objects to such reliance on Official Notice, and reserves all rights to request that the Examiner provide a reference or affidavit in support of such assertion, as required by MPEP § 2144.03. Applicant reserves all rights to pursue any cancelled claims in a subsequent patent application claiming the benefit of priority of the present patent application, and to request rejoinder of any withdrawn claim, as required by MPEP § 821.04.

**CONCLUSION**

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612) 373-6944 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.


Respectfully submitted,

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**CERTIFICATE UNDER 37 CFR 1.8:** The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 3<sup>rd</sup> day of April 2007.

PATRICIA A. HULTMAN

Name

Signature